

REMARKS

Claims 1, 5, 7, and 8-11 have been amended.

Applicant respectfully requests further examination of claims 1-11, now pending in the application.

The first Office Action mailed from the Patent Office on April 28, 2004 has been carefully considered and indicates that:

- a) Claims 8-11 are rejected under 35 U.S.C. § 101 because they are directed to non-statutory subject matter;
- b) Claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dunlop; and
- c) Claims 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlop in view of Chiloyan.

In response to the Examiner's rejection of claims 8-11 under 35 U.S.C. § 101 because they are directed to non-statutory subject matter, applicant has amended line 1 of claims 8-11 to change "method" to --hardware implemented method-- as so graciously suggested by the Examiner. Such amendment does not relate to the prior art.

In view of the amendments made *supra* to line 1 of claims 8-11 to change "method" to --hardware implemented method--, applicant respectfully submits that the Examiner's grounds for the rejection of claims 8-11 under 35 U.S.C. § 101 because they are directed to non-statutory subject matter are no longer applicable and applicant therefore respectfully requests that the Examiner withdraw this rejection.

In response to the Examiner's rejection of claims 1-7 under 35 U.S.C. § 102(e) as being anticipated by Dunlop and the Examiner's rejection of claims 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Dunlop in view of Chiloyan, applicant has amended claims 1, 5, 7, and 8, and respectfully submits that claim 1 discloses at least the following advantageous distinctive features that distinguish over and avoid the prior art:

"a storage component for storing a plurality of bitstreams that configure the configurable hardware interface to implement a driver of the external device".

Claim 8 discloses at least the following advantageous distinctive features that distinguish over and avoid the prior art:

- a) "storing a plurality of bitstreams in the host device, the plurality of bitstreams corresponding to drivers"; and
- b) "configuring a programmable logic device (PLD) in the host device with the bitstream to implement the driver of the peripheral device".

The advantages of advantageous distinctive features of claims 1 and 8 discussed *supra* are presented *infra* to show the criticality of advantageous distinctive features of claims 1 and 8 so as to show that advantageous distinctive features of claims 1 and 8 are not merely a matter of design choice.

1. Improved performance during reconnect of a peripheral. Once a peripheral has been connected to the electronic device, that peripheral can be reconnected to the device at any time in the future with the device remembering how

to connect to and communicate with the peripheral without repeating setup. By storing information about peripherals in the device, when a peripheral is invoked, the drivers for that piece of hardware may be loaded dynamically.

2. Missing or lost drivers are no longer a problem. Most devices are delivered with the driver on a CD. Unfortunately, after the device is connected, the CD is often misplaced or lost. By storing information about peripherals in the device, the CD is no longer needed and access to the Internet is not necessary to recover a lost driver, thereby ensuring that a peripheral will not become useless due to unavailability of drivers.

In contradistinction, Dunlop does not teach "a storage component for storing a plurality of bitstreams that configure the configurable hardware interface to implement a driver of the external device", "storing a plurality of bitstreams in the host device, the plurality of bitstreams corresponding to drivers", and "configuring a programmable logic device (PLD) in the host device with the bitstream to implement the driver of the peripheral device" as required by advantageous distinctive features of claims 1 and 8, but rather Dunlop is silent as to drivers and what is connecting to it. Absent such a disclosure, one cannot say that Dunlop teaches advantageous distinctive features of claims 1 and 8. In fact, Dunlop merely discloses only conventional driver software. (Dunlop at col. 7, lines 30-41.)

In further contradistinction, Chiloyan does not teach "a storage component for storing a plurality of bitstreams that configure the configurable hardware interface to implement a driver of the external device", "storing a plurality of bitstreams in the host device, the plurality of bitstreams

corresponding to drivers", and "configuring a programmable logic device (PLD) in the host device with the bitstream to implement the driver of the peripheral device" as required by advantageous distinctive features of claims 1 and 8, but rather Chiloyan teaches storing the drivers on the remote device and not on the host.

The disadvantage of this arrangement of Chiloyan is that every time the peripheral is reconnected, the bitstreams have to be reloaded into the host and the setup procedure has to be repeated again and again.

Hence, each of Dunlop and Chiloyan neither discloses nor teaches advantageous distinctive features of claims 1 and 8, and for at least this reason alone, claims 1 and 8 should be allowable.

Regarding the Examiner's statement made at page 8, ¶ 18, lines 1-4 of the Office Action that "It would have been obvious to a person of ordinary skill in the art at the time the invention to apply the teaching [of Chiloyan] of determining if one of the predetermined drivers is a driver of the peripheral device, selecting that driver if it is, otherwise, receive a driver from the peripheral device...to the invention of Dunlop...", applicant respectfully submits that there is no motivating suggestion either in the references themselves or in the knowledge of one skilled in the art provided by the Examiner to modify the invention of Dunlop to apply the determining if one of the predetermined drivers is a driver of the peripheral device, selecting that driver if it is, otherwise, receive a driver from the peripheral device of Chiloyan as suggested by the Examiner. The Examiner has merely combined elements in a piecemeal manner in light of applicant's disclosure to show obviousness by using applicant's own disclosure as though it were prior art, and in

so doing, has violated the basic mandate of 35 U.S.C. § 103 that a piecemeal reconstruction of the prior art in light of applicant's disclosure shall not be the basis for a holding of obviousness. *In re Kamm and Young*, 172 USPQ 298 at 301 ("The rejection here runs afoul of a basic mandate inherent in section 103 - that a 'piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. *In re Rothermel*, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331, (1960)".).

Regarding claims 2-7, since claims 2-7 depend from claim 1, claims 2-7 should be allowed for at least the same reasons claim 1 is allowed.

Regarding claims 9-11, since claims 9-11 ultimately depend from claim 8, claims 9-11 should be allowed for at least the same reasons claim 8 is allowed.

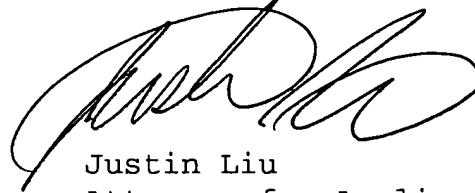
In view of the amendments made *supra* to claims 1, 5, 7, and 8, and the arguments presented *supra*, applicant respectfully submits that the Examiner's grounds for the rejection of claims 1-7 under 35 U.S.C. § 102(e) as being anticipated by Dunlop and the Examiner's grounds for the rejection of claims 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Dunlop in view of Chiloyan are no longer applicable and applicant therefore respectfully requests that the Examiner withdraw these rejection.

CONCLUSION

All claims should now be in condition for allowance and a Notice of Allowance is respectfully requested.

If there are any questions, the applicant's attorney can be reached at Tel: 408-879-4641 (Pacific Standard Time).

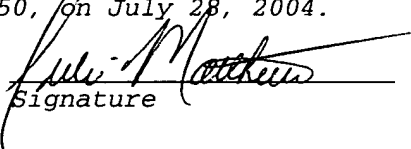
Respectfully submitted,



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*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on July 28, 2004.*

Julie Matthews  
Name

  
Signature